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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/014,327   | 11/13/2001  | Oren Rosenfeld       | U 013718-2          | 1497             |
| 7590   | 12/15/2004  |                      | EXAMINER            |                  |
| Ladas & Parry<br>26 West 61 Street<br>New York, NY 10023 |             |                      | CHANAY, CAROL DIANE |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1745                |                  |

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/014,327             | ROSENFELD ET AL.    |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Carol Chaney           | 1745                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 13 November 2001.

2a)  This action is **FINAL**.                                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-224 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) 1-224 are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-38 and 219, drawn to electric power generator having a hydrogen generator employing a water-based fuel, classified in class 429, subclass 12.
- II. Claims 39-63 and 220, drawn to an electric power generator where the extent of availability of catalyst for a hydrogen generator is controllable, classified in class 48 subclass 61.
- III. Claims 64-74 and 221, drawn to an electric power generator with an "ion-plated, palladium-containing generally non-porous ion-exchange membrane class 429 subclass 30.
- IV. Claims 75-102, drawn to an electronic shelf label using the power generator of Group I, classified in class 345, subclass 4.
- V. Claims 103-127, drawn to an electronic shelf label, using the power generator of Group II, classified in class 345 subclass 4.

- VI. Claims 128-138, drawn to an electronic shelf label using the power generator of Group III, classified in class 345, subclass 4.
- VII. Claims 139-154 and 222 drawn to a method for electrical power generation, employing a hydrogen generator using a water-based fuel, classified in class 290, subclass 16.
- VIII. Claims 155-166 and 223, drawn to a method of electrical power generation in which availability of catalyst and water is controlled, classified in class 290, subclass 18.
- IX. Claims 167-168 and 224 drawn to a method of electrical power generation using a fuel cell with an "ion-plated, palladium containing" membrane, classified in class 429 subclass 13.
- X. Claims 169-184 drawn to a method of operating an electronic shelf label by using a water-based fuel, classified in class 345, subclass 211
- XI. Claims 185-196 drawn to a method of operating an electronic shelf label by controlling availability of catalyst and water, classified in class 345, subclass 212.

XII. Claims 197-198 drawn to a method of operating an electronic shelf label by using a fuel cell with an "ion-plated, palladium containing" membrane, classified in class 345, subclass 212.

XIII. Claims 199-200, drawn to method and means for recharging an electric power generator, classified in class 320, subclass 137.

XIV. Claims 201, 207, and 213 drawn to toys, including electronic computing systems or mobile communication systems, employing a hydrogen generator using a water-based fuel, classified in class 446, subclass 484.

XV. Claims 202, 208 and 214, drawn to toys classified in class 446, subclass 484.

XVI. Claims 203, 209 and 215, drawn to toys powered by the invention of Group III, classified in class 446, subclass 484.

XVII. Claims 204, 210 and 216 drawn to a methods of operating electronic systems by using a water based fuel, classified in class 204 subclass 157.52.

XVIII. Claims 205, 211, and 217 drawn to methods of operating electronic systems by controlling availability of catalyst and water, classified in class 252 subclass 182.1.

XIX. Claims 206, 212, and 218, drawn to methods of operating electronic systems by using a fuel cell with an "ion-plated, palladium containing" membrane classified in class 429, subclass 33

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different functions.

Inventions IV-VI and XIV- XVI are related to inventions I-III as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because each of the combinations, i.e. a shelf label, a toy, an electronic computing system or a mobile

communication system is claimed as operable with each of the subcombination power generation systems. The subcombinations each have separate utility such as operating the other devices claimed.

Inventions VII-XIII are related to inventions I-III as processes and apparatus for their practice. Inventions X-XII are related to inventions IV-VI as processes and apparatus for their practice. Inventions XVII –XIX are related to inventions XIV-XVI as processes and apparatus for their practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case any of the apparatus of groups I-III can be used to practice any of the processes VII-XIII; any of the apparatus of groups IV-VI can be used to practice any of the processes X-XII; any of the apparatus of groups XIV-XVI can be used to practice any of the processes XVII – XIX.

Inventions XIII and the others are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operating, since recharging and discharging power generators are considered to be distinct functions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Julian Cohen on 07 December 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol Chaney whose telephone number is (571) 272-1284. The examiner can normally be reached on Mon - Fri 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Carol Chaney  
Primary Examiner  
Art Unit 1745

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